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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,374	07/03/2003	Sudhin Datta	98B037A/2	7189

23455 7590 03/21/2005

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EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

LD

## Office Action Summary

Application No.

10/613,374

Applicant(s)

DATTA ET AL

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2005.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 39,40 and 43-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47-62 and 69-98 is/are allowed.
- 6) ☒ Claim(s) 39,40,43-46 and 63-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The rejection of claims 39-48 under 35 U.S.C. 102(e) as being clearly anticipated by Saito et al ('505) is hereby expressly withdrawn.

The rejection of claims 39-44, 47 and 48 under 35 U.S.C. 102(b) as being clearly anticipated by Asanuma et al ('389) is hereby expressly withdrawn.

The rejection of claims 39, 41, 43, 45 and 47 under 35 U.S.C. 102(e) as being anticipated by Wouters ('847) is hereby expressly withdrawn.

The rejection of claims 39, 41 and 47 under 35 U.S.C. 102(e) as being anticipated by Kaufman et al ('856) is hereby expressly withdrawn.

The rejection of claims 39-48 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,372,847 is hereby expressly withdrawn.

The rejection of claims 39-42, 47 and 48 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,245,856 is hereby expressly withdrawn.

### ***Allowable Subject Matter***

Claims 47-62 and 69-98 are allowed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39, 40, 43-46 and 63-68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The Specification, as filed, does not appear to support the recitations of the claims with regards to the particular physical property of the inherent X-ray diffraction pattern. The Declaration of Rufina Alamo states conclusively that the "propylene-ethylene copolymers of the type made using the process of Applicants' Example 1 and having an ethylene content of up to at least 11.6 weight percent (e.g., SPC-1 and SPC-3) have more gamma-form crystals than a comparable copolymers (*sic*) made using a Ziegler-Natta catalyst." While it is agreed that the "compositions of the present invention may comprise from about 5% to about 99% by weight of the SPC," nothing is disclosed concerning the "optional" constituent SPC2. Nothing is taught regarding the inclusion of this "optional" constituent as to compositional limitations. Since the constituent is "Optional" it is not clear, nor can it be inferred that this copolymer represents "about 5% to about 99% by weight" of the total composition, as claimed. Further, the Declaration at page 3, paragraph 9, refers to "the exemplary

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copolymer SPC2 that is discussed at page 44 of the Datta '374 application." The Declaration states that the "SPC2 had an ethylene content of 5.8 weight percent (8.45 mole %)" and concludes "that a slow crystallization of SPC2 would result in greater than 90% of the gamma polymorph for all crystals formed under the described conditions (see Datta '374 application, Example 1, pp. 35-36)." The SPC2 referred to is not even documented in the Table 7. Further, it is pointed out that this SPC2 differs from the SPC2 disclosed at page 37 in Table 1 which has an ethylene content of 9.4 wt. %. In the analysis purported to show the X-ray diffraction pattern, the Amendment and Reply to Office Action states that "(a)s demonstrated in the Declaration of professor Rufina G. Alamo, propylene-ethylene copolymers of the type made using the process of Applicants' Example 1 and having an ethylene content of up to at least 11.6 weight percent (e.g., SPC-1 and SPC-3) have more gamma-form crystals than a comparable copolymers made using a Ziegler-Natta catalyst." That Declaration DOES NOT refer to "SPC-1" or "SPC-3." Furthermore, there is no comparison present to any copolymer produced from a Ziegler-Natta catalyst, only speculation. It is not understood by this Examiner why any property that may be measured by known testing means would necessarily need to be inferred from literature rather than from direct observation and testing. The property of having "an X-ray diffraction pattern that exhibits more gamma-form crystals than a copolymer comparable in all respects except that it is prepared with a Ziegler-Natta catalyst" is measurable. Further, it is pointed out that from the entirety of the Specification, this teaching of picking one isolated example from the entirety of the disclosure fails to support the claims, as now filed, since the application is not viewed in

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minute teachings recounted to support the claim, as drafted. This declaration, as filed, cannot be used to cure the deficiencies of the disclosure since it is deficient in its own assumptions providing only speculation.

### ***Response to Arguments***

Applicant's arguments filed 25 January 2005 have been fully considered but they are not persuasive.

It is conceded that the "addition of inherent characteristics is permissible," to the language of a claim. While inherent characteristics are permissible, where a particular characteristics may or may not be inherent, this cannot be permitted, because of the level of uncertainty. Separate compositions having the same monomeric and polymeric constituents, produced in the identical compositional limitations, may express different morphologies, such as the "X-ray diffraction pattern that exhibits more gamma-form crystals than a copolymer comparable in all respects except that it is prepared with a Ziegler-Natta catalyst," may be dependent upon their randomness, chemical structures, steric relationships, degree of crystallinity, etc. Note the final paragraph of Stevens et al (Polymer Chemistry), newly cited, at page 140. Note pages 384-385 of Rudin (The Elements of Polymer Science and Engineering), newly cited. Finally, note pages 237-242 of Painter et al (Fundamentals of Polymer Science), newly cited. As such, this feature, which finds no direct comparative evidence, either as originally filed or submitted by affidavit evidence, would not be deemed to be inherent.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nathan M. Nutter  
Primary Examiner  
Art Unit 1711

nmn

17 March 2005